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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/141,496	10/22/1993	MARCUS F. BOEHM	203268	7787

7590 05/06/2003

JESSICA R. WOLFF
BROBECK, PHLEGER AND HARRISON LLP
12390 EL CAMINO REAL
SAN DIEGO,, CA 92130

EXAMINER

KILLOS, PAUL J

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 05/06/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☐ This application has been examined ☐ Responsive to communication filed on 21 April 03 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire three month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☐ Claims 64-70 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims 1-63 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☐ Claims 64-66 and 70 are rejected.
5. ☐ Claims 67-69 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____, Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

The allowance is hereby withdrawn and the claims rejected.

The claims are 64-70.

REJECTION, 35 U.S.C. 112 2ND PARAGRAPH FAILURE TO PARTICULARLY
POINT OUT AND DISTINCTLY CLAIM (INDEFINITE)

Claims 64 and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

BROADER RANGE/LIMITATION AND NARROW RANGE/LIMITATION IN
SAME CLAIM.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 64 recites the broad

recitation cycloalkyl, and the claim also recites cyclopropyl, which is the narrower statement of the range/limitation.

REJECTION, 35 U.S.C 112, 1ST PARAGRAPH; SCOPE OF ENABLEMENT

Claim 64 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for R' R" each independently representing hydrogen or lower alkyl, does not reasonably provide enablement for but both are not hydrogen. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The specification is not enabling for when both 12' and R" are lower alkyl. The specification lacks sufficient support for the changes made, applicants are changing the scope of the invention.

STATEMENT OF STATUTORY BASIS, 35 U.S.C. 112, FIRST PARAGRAPH

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

REJECTION. 35 U.S.C. 112 1ST PARAGRAPH DESCRIPTION REQUIREMENT,
INCLUDING NEW MATTE SITUATION

Claim 64 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The requirement that "R" and R" are not both

hydrogen" in considered new matter. Applicants are entitled to narrow an existing claim but not change the limitations of the claim. In claim 65, R' and R" may both be hydrogen. The only difference between claims 64 and 65 is that the structures in claim 65 have as R₅ substituent, and yet applicant intent to give different limits for R' and R".

GRAHAM V. DEERE, TEST FOR OBVIOUSNESS

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

STATEMENT OF STATUTORY BASIS, 35 U.S.C. 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

REJECTION, 35 U.S.C. 103(a)

Claims 64-66 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPO 0,260,162 published 16 March 1988.

The compounds claimed and the compounds taught by the reference are considered analogous. The primary difference between the first structural formula of claim 64 and the formula shown in the reference is the change (new matter) in claim 64.

Applicants have introduced now matter by introducing the requirement that at least one of R' and R'' may not be hydrogen. The formulas of a claim 65 differ from the structures taught by the reference in the R₅ substituent on the naphthyl portion, fused rings, of the molecule. However, this is not deemed to be a critical feature as demonstrated by the structural formulas of claim 64. The presence of R₅ is not a requirement for the pharmaceutical properties of the claimed compounds.

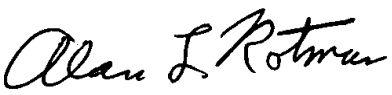
Claims 67-69 are objected to as being dependent on rejected claims.

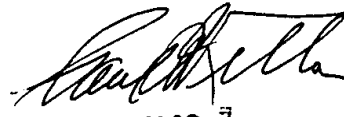
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul J Killos whose telephone number is 308-0135. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 308-1701. The fax phone numbers for the organization where this application or proceeding is assigned are 308-4556 for regular communications and 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Killos/LR
May 5, 2003


ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600


PAUL J. KILLOS
PRIMARY EXAMINER
A.U. 1625